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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,783	09/12/2003	Werner Honegger	P56949	5861
8439 7590 02/26/2009 ROBERT E. BUSHNELL & LAW FIRM 2029 K STREET NW SUITE 600 WASHINGTON, DC 20006-1004			EXAMINER MORRISON, THOMAS A	
			ART UNIT 3653	PAPER NUMBER
			MAIL DATE 02/26/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/660,783

Applicant(s)

HONEGGER, WERNER

Examiner

THOMAS A. MORRISON

Art Unit

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32-62 is/are pending in the application.
- 4a) Of the above claim(s) 48-62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 32-47 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/6/2008 has been entered.

Election/Restrictions

2. Regarding applicant's remarks about the restriction requirement in this case, the petition decision of 2/4/2009 addresses these arguments and upholds the restriction requirement. Claims 48-62 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Claim Objections

3. Claims 35-36 are objected to because of the following informalities: (1) "removal" in line 4 of claim 35 should be -- separation --; and (2) "rotation" in line 2 of claim 36 should be -- the erecting --. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 32-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 32, it is unclear what is meant by the recitation “**erecting the flexible objects** during said product feed along the guide into obliquely standing positions with leading upper edges of the flexible objects exhibiting inclinations opposite to orientations of the flexible objects **when initially erected**”. (emphasis added). If you are in the process of erecting the flexible objects, how do you change the orientation of the flexible objects relative to when the objects are initially erected? This recitation appears to be inaccurate. It appears that one possible solution may be to amend claim 32 to recite “erecting the flexible objects during said product feed along the guide into obliquely standing positions with leading upper edges of the flexible objects exhibiting inclinations opposite to orientations of the flexible objects when initially erected fed along the guide”.

In claim 32, it is unclear what is meant by the recitation “accommodating separation of the flexible objects from the obliquely standing positions with leading upper edges of the flexible objects exhibiting inclinations opposite to orientations of the flexible objects **when erected**” (emphasis added). Does the recited “when erected” refer back to the previously recited “erecting the flexible objects” in line 8 of claim 32 or

the previously recited "when initially erected" in line 10 of claim 32? Further clarification is requested.

Regarding claim 33, it is generally unclear what is meant by the recitation "comprised of the flexible objects during said advance of the flexible objects over the surface of the guide being continuously rotated from the orientations of the flexible objects in said obliquely standing position **and inclined opposite to orientations of the flexible objects when erected.**" (emphasis added).

Claim 37 recites "contributing to rotation by sequentially urging upper edges of the flexible objects in a direction of said advance". Contributing to rotation of what element? One possible solution would be to amend claim 37 to recite "contributing to said erecting of said flexible objects..."

Claim 38 recites "contributing to rotation by individually regulating movement of a plurality of conveyers disposed along said guide to movingly engage the lower edges". Contributing to rotation of what element? One possible solution would be to amend claim 38 to recite "contributing to **said erecting** of said flexible objects..."

Claim 39 recites "contributing to rotation by terminating said guide with an abutment oriented outwardly from said guide in a direction of said advance". Contributing to rotation of what element? One possible solution would be to amend claim 39 to recite "contributing to **said erecting** of said flexible objects..."

Claims 40-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, MPEP, section 2173.05(p) states,

"A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph." Id. Claim 32 recites a method for processing and separating flexible, flat objects during product feed" and then recites specific method steps. Then, claims 40-47, which depend from claim 32, merely recite structural elements that further define an apparatus, rather than setting forth additional method steps or clarifying previous method steps. Since claim 32 and its dependent claims 40-47 claim both an apparatus and the method steps of using the apparatus, these claims are indefinite. Applicant should set forth method steps in claims 40-47.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 40-47 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In particular, claims 40-47 are directed to neither a "process" nor a "machine," but rather embrace or overlap two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. See, MPEP, section 2173.05(p). More specifically, claims 40-47 recite both a process and a machine.

Response to Arguments

6. Applicant's arguments filed 3/6/2008 have been fully considered but they are not persuasive with regard to the rejections under 35 U.S.C. 112. The indefiniteness rejections of claims 32-47 are outlined above. Some suggestions are

also included for fixing some of the indefiniteness problems. Applicant is welcome to contact the examiner to try to work out language to address the indefiniteness issues outlined above.

Allowable Subject Matter

7. Claims 32-39 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. It is not known how the rejections of claim 40-47 will be addressed. As such, no determination of allowability of these claims can be made at this time.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to THOMAS A. MORRISON whose telephone number is (571)272-7221. The examiner can normally be reached on M-F, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey can be reached on (571) 272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Patrick H. Mackey/
Supervisory Patent Examiner, Art
Unit 3653

2/20/2009